

Remarks:

Claims 51-70 are pending. Applicant has amended the claims to distinctively claim the subject matter of the invention. By virtue of this amendment, claim 51 has been amended. No new matter has been added as support for the amendments is found within the specification and the drawings. It is submitted that the application, as amended, is in condition for allowance.

§112 Rejection(s):

Claims 51-70 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. These rejections are respectfully traversed.

Claim 51 was rejected for failing to particularly point out and distinctly claim “displaying at least first and second icons in a second display area of the display screen, wherein the first and second display areas are non-overlapping.” Claims 51-56, 58-59, and 61 were rejected for failing to particularly point out and distinctly claim “wherein the first and second display areas are non-overlapping.”

On page 21 of the Office Action, the Examiner contends that FIG. 3B shows an icon E that is overlapping with the image of size C*D. It is respectfully submitted that FIG. 3B only shows one embodiment of the invention. In other embodiments, the first and second display areas may be non-overlapping. (Please refer to the arguments provided below with regard to support in the specification.) In claim 51, Applicant has chosen to particularly point out and distinctly claim the non-overlapping embodiments of the claimed subject matter.

The Examiner also contends that “an empty space may be generated on lower end of the image on the display unit 103” as stated in paragraph [0024] of the specification is remote from the claim limitation of “displaying at least first and second icons in a second display area of the display screen, wherein the first and second display areas are non-

overlapping.” Applicant respectfully disagrees. Generating an empty space is directly related to the above claim limitation because the second display area may be positioned in the empty space, which, by definition, is non-overlapping with the first display area.

At the bottom of page 21 of the Office Action, the Examiner contends that the specification does not disclose “the first and second display areas are non-overlapping.” It is respectfully noted that this issue is moot because the Examiner has acknowledged sufficient written description in the specification by withdrawing the §112 second paragraph rejection in that respect.

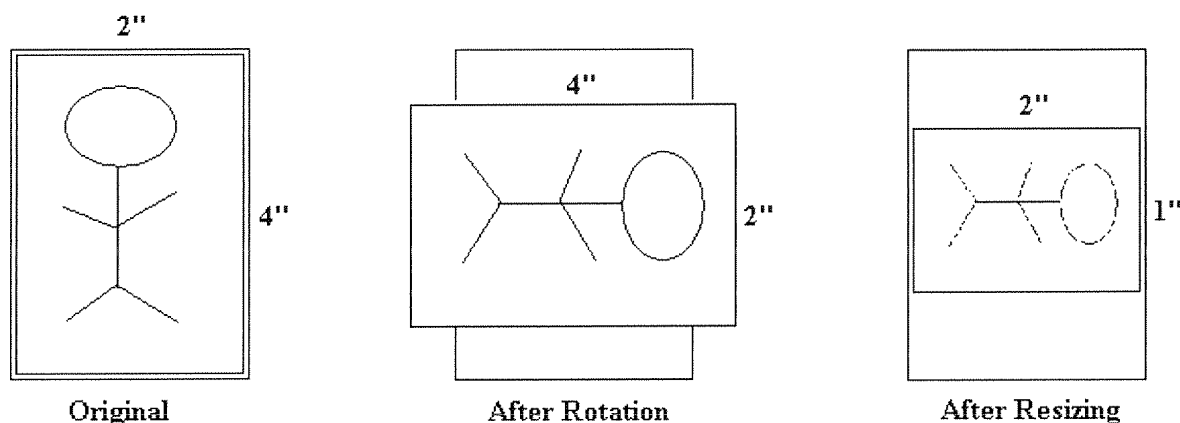
Regardless, claim limitations may be supported in the specification through “express, implicit, or inherent disclosure.” See In re Oda, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971). Thus, a word-for-word matching between the language in the specification and the language recited in the claims is not required. Moreover, referring to MPEP 2163 (II) (A), “[t]here is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed, Wertheim, 541 F.2d at 262, 191 USPQ at 96.” The burden is on the Examiner to provide specific detail to overcome that presumption. The Examiner has not provided any support for his position, other than, simply making an allegation citing to § 112.

As stated previously, paragraph [0024] of the specification discloses “an empty space may be generated on lower end of the image on the display unit 103.” By definition, the empty space is non-overlapping with the first display area. Also, a person of ordinary skill in the art, reviewing the specification, would clearly understand that the empty space could comprise the second display area. Thus, the specification implies that the first and second display areas could be non-overlapping.

On page 22 of the Office Action, the Examiner contends that claim 52, which recites “first image and the third image have approximately same aspect ratio,” contradicts claim 51, which recites “a width or a height of the second image are adjusted in size” and “the third image comprises a scaled version of the second image.” Examiner

also contends, with regard to claims 57 and 64, that the second image having an approximately same aspect ratio as the first image implies that a width and a height of the second image is not adjusted in size and thus not supported in the specification.

Regarding claim 52, the Examiner is well-aware that an adjustment in size of an image does not necessitate a change in that image's aspect ratio. Regarding claims 57 and 64, a same aspect ratio does not mean that there has been no adjustment in size. For example, referring to the illustration provided below, an image with a width of 2 inches and a height of 4 inches has a width of 4 inches and a height of 2 inches after a 90-degree rotation. If the display screen has a width of only 2 inches, the image is resized so that it has a width of 2 inches and a height of 1 inch. Thus, the aspect ratio of the original image before the rotation (2:4) is the same as the aspect ratio of the image after resizing (1:2). The width and height are changed, but the aspect ratio remains the same.



In fact, paragraph [0030] of the specification states “[i]mage distortion problems due to the difference in width and length of the display unit is solved by applying the aspect ratio of the original image to the rotated image, and/or by reducing the size of the rotated image.” Thus, a rotated image, having a same aspect ratio as the original image and having been resized, is explicitly disclosed in the specification.

For the above reasons, Applicant respectfully requests that the §112 grounds of rejection be withdrawn.

§103 Rejection(s):

Claims 51-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,154,214 to Uyehara et al. (hereafter “Uyehara”) in view of U.S. Patent No. 5,661,632 to Register (hereafter “Register”) and U.S. Patent No. 6,747,680 to Igarashi et al. (hereafter “Igarashi”).

MPEP §2143 provides:

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

Uyehara fails to disclose at least one of the elements recited in claim 51, as amended. In particular, Uyehara fails to disclose “wherein a width or a height of the second image is adjusted in size so that a third image is displayed in entirety in the first display area of the display screen, wherein the third image comprises a scaled version of the second image, and wherein the third image is a scaled and rotated version of the first image in its entirety, and displaying at least first and second icons in a second display area of the display screen, wherein the first and second display areas are non-overlapping and the second display area is positioned between the first display area and at least one edge of the display screen, and wherein the first and second icons are associated with a function for controlling image display on the hand-held mobile communication terminal, wherein the second display area is formed from the empty space created when the first image is rotated at approximately a ninety degree angle and resized to the third image, and wherein the first and second icons are displayed without requiring the mobile communication terminal to be in an orientation mode,” as recited in amended claim 51.

On the middle of page 25 of the Office Action, with regard to Uyehara, the Examiner agrees with Applicant that, due to image rotation, the original text characters

displayed in the first image may not fit into the display area for the second image and that less text characters are displayed. However, Examiner contends that because Uyehara discloses that the text characters are re-arranged after rotation, having less text characters displayed does not mean that Uyehara teaches away from the claim limitation that the third image is a rotated version of the first image in its entirety.

Applicant respectfully disagrees. Uyehara does not disclose that the text characters are re-arranged after rotation. However, even if Uyehara did disclose that text is re-arranged (which, by the way, is only possible with text, not images), it is undeniable that text that does not fit in the display area is not displayed in the display area. Displaying some of the text in the display area is inconsistent with displaying the text in entirety in the display area. Thus, Uyehara directly teaches away from “a third image is displayed in entirety in the first display area of the display screen,” as recited in claim 51.

Additionally, Uyehara directly teaches away from “displaying at least first and second icons in a second display area of the display screen, wherein the first and second display areas are non-overlapping,” as recited in claim 51. Uyehara fails to disclose the graphical orientation markers are overlapping. Particularly, Uyehara explicitly teaches that the markers are superimposed over the displayed text (see column 12, lines 5-6). Further, Uyehara suggests that the rotation icon and hotkey icon 82 are displayed in a second display area. Respectfully, the rotation icon and hotkey icon 81 are not analogous to the icons recited in claim 51. The icons disclosed in Uyehara are for displaying the orientation markers, not for controlling the orientation direction like the icons recited in claim 51.

Further, Uyehara directly teaches away from “wherein the first and second icons are displayed without requiring the mobile communication terminal to be in an orientation mode,” as recited in claim 51. Uyehara teaches having to press an orientation key before displaying the orientation markers (see column 12, lines 4-6) and requiring two taps to change orientation (see column 12, line 20).

Register discloses a handheld computer that selectively rotates, “through an angle of 90 degrees, the orientation of data generated on the screen so that in either of the first and second housing use orientations the screen data is in an upright viewing orientation relative to the user of the computer (see Abstract).” Register fails to cure the deficiencies of Uyehara as Register also fails to disclose “wherein a width or a height of the second image is adjusted in size so that a third image is displayed in entirety in the first display area of the display screen, wherein the third image comprises a scaled version of the second image, and wherein the third image is a scaled and rotated version of the first image in its entirety, wherein the second display area is formed from the empty space created when the first image is rotated at approximately a ninety degree angle and resized to the third image,” as recited in claim 51.

Igarashi discloses a system and method for navigating through a content or document in a display, wherein as the rate of such navigation increases, the scale of the document decreases (see Abstract). Igarashi fails to cure the deficiencies of Uyehara and Register as Igarashi also fails to disclose “wherein a width or a height of the second image is adjusted in size so that a third image is displayed in entirety in the first display area of the display screen, wherein the third image comprises a scaled version of the second image, and wherein the third image is a scaled and rotated version of the first image in its entirety, wherein the second display area is formed from the empty space created when the first image is rotated at approximately a ninety degree angle and resized to the third image,” as recited in claim 51.

Further, Igarashi teaches away from “displaying at least first and second icons in a second display area of the display screen, wherein the first and second icons are associated with a function for controlling image display,” as recited in claim 51. It is respectfully noted that the scaling proposed by Igarashi is directed to a zooming in function that is associated with the speed of navigation, while the scaling recited in claim 51 is associated with a rotation function that is related to user interaction with orientation icons.

For the above reasons, all the cited references teach away from the elements recited in claim 51 and should be withdrawn. Further, the cited references, alone or in combination, fail to disclose at least one of the elements recited in claim 51.

While the suggestion to modify or combine references may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998) (emphasis added).

Here, the modification or combination proposed by the Examiner is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion and motivation for the combination of references proposed by the Examiner simply is impermissible hindsight reconstruction given the benefit of Appellant's disclosure.

The Federal Circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. § 103. In re Geiger, 2 USPQ 2d 1276 (Fed Cir. 1987). Unfortunately, the Examiner rather than pointing to what the prior art discloses and teaches as to making the suggested modification relies on assumptions and statements without any support in the record. As such, the Examiner's statements regarding obviousness and motivation to modify are but shortcuts to a conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicant's claimed invention cannot establish a prima facie case of obviousness. Since obviousness may not be established by hindsight reconstruction, Applicants invite the Examiner to point out the alleged motivation to combine with specificity,¹ or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.²

Since no reasonable justification is provided in the Office Action as to how such modification or combination is possible and obviousness may not be established based on hindsight and conjecture, it is respectfully requested that the 103 grounds of rejection be withdrawn.

Therefore, it is respectfully submitted that claim 51 is in condition for allowance. Claims 57 and 64 recite elements similar to claim 51 and thus are also in condition for allowance. In particular, claims 57 and 64 recite "wherein the second image is a scaled and rotated version of the first image in its entirety." Claims 52-56, 58-63, and 65-70, should be allowable by virtue of their dependency on allowable independent claims 51, 57, and 64.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has expressly argued herein that such

¹ *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

² "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

amendment was made to distinguish over a particular reference or combination of references.

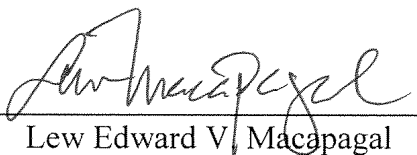
If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (888) 789 2266 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

LEE, HONG, DEGERMAN & SCHMADEKA

Date: September 24, 2008

By:

A handwritten signature in black ink, appearing to read "Lew Macapagal", written over a horizontal line.

Lew Edward V. Macapagal

Registration No. 55,416

Attorney for Applicant